

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	POST	Examiner:	MAYO, TARA L
Serial No.:	10/649,152	Group Art Unit:	3671
Filed:	AUGUST 27, 2003	Docket No.:	1810US01
Confirmation No.:	5019		
Title:	RESCUE UNDERLAY FOR MATTRESSES		

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**ELECTRONICALLY FILED ON FEBRUARY 11, 2008**

**APPELLANT'S REPLY BRIEF**

Mail Stop: Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Appellant's Reply Brief is being filed in response to the Examiner's Answer mailed December 13, 2007.

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers or any future reply, if appropriate. Please charge any additional fees or credit overpayment to Deposit Account No. 501257.

### **STATUS OF CLAIMS**

Fifteen claims were filed with the application. A preliminary amendment was filed on August 27, 2003 canceling the original fifteen claims and adding thirty new claims (claims 16-45). One claim was later cancelled (see Amendment of October 8, 2004 cancelling claim 19). Claims 16-18 and 20-45 were pending when this appeal was filed.

No claims are allowed. New grounds of rejection have been presented in the Examiner's Answer of December 13, 2007. Claims 16-45 are rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 16-18, 20-24, 26-28, 30, 33, 34, and 42-45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hemphill (U.S. Pat. No. 5,150,487) in view of Böttger et al. (U.S. Pat. No. 5,582,893). Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hemphill (U.S. Pat. No. 5,150,487) in view of Böttger et al. (U.S. Pat. No. 5,582,893) and further in view of Failor (U.S. Pat. No. 5,860,174). Finally, claims 31 and 35-41 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hemphill (U.S. Pat. No. 5,150,487) in view of Böttger et al. (U.S. Pat. No. 5,582,893). All of these rejections are being appealed.

### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The grounds of rejection to be reviewed on appeal include the following:

**I. Whether claims 16-45 are indefinite under 35 U.S.C. §112, second paragraph.**

The Examiner's Answer of December 13, 2007 asserts that the phrase "wherein the mattress is substantially the same size of a mattress" is indefinite. See Examiner's Answer, paragraph 2 on page 3. The Examiner's Answer states that it is not proper for Applicant to compare the features of the claimed invention to elements that are not part of the claimed invention.

**II. Whether claims 16-18, 20-24, 26-28, 30, 33, 34, and 42-45 are unpatentable under 35 U.S.C. § 103(a) over Hemphill (U.S. Pat. No. 5,150,487) in view of Böttger et al. (U.S. Pat. No. 5,582,893) (hereinafter "Hemphill" and "Böttger et al.").**

The March 3, 2006 Final Rejection (hereinafter "Final Rejection") asserts that Hemphill discloses all of the features of the Appellant's invention except for the features of the spacer woven fabric. See Final Rejection paragraph 3 on pages 2-4. The Final rejection uses Böttger et al. to teach the elements of the spacer woven fabric and states that "it would have been obvious to one having ordinary skill in the art of beds at the time of invention to modify the device shown by Hemphill '487 such that the flat material would comprise woven material as taught by Böttger et al. '893. The motivation would have been to enhance the dimensional stability of the material." See Final Rejection, paragraph 3, page 5.

**III. Whether claim 25 is unpatentable under 35 U.S.C. § 103(a) over Hemphill (U.S. Pat. No. 5,150,487) in view of Böttger et al. (U.S. Pat. No. 5,582,893) and further in view of Failor (U.S. Pat. No. 5,860,174) (hereinafter “Failor”).**

The March 3, 2006 Final Rejection asserts that Hemphill and Böttger et al. disclose all of the features of the claimed invention in claim 25 except for “the plastic film being selected from the group consisting of polyurethane, polyester, and combinations thereof.” See Final Rejection, paragraph 4 on page 5 bridging page 6. The Final Rejection states that Failor ‘174 discloses a patient transfer mattress where the bottom surface comprises a fluoropolymer film combined with a polyester fabric substrate and that it would have been obvious to a person skilled in the art of making beds at the time of the invention to modify the device shown by the combination of Hemphill and Böttger et al. to include the plastic film taught by Failor. See Final Rejection, paragraph 4, page 6.

**IV. Finally, whether claims 31 and 35-41 are unpatentable under 35 U.S.C. §103(a) over Hemphill (U.S. Pat. No. 5,150,487) in view of Böttger et al. (U.S. Pat. No. 5,582,893).**

The March 3, 2006 Final Rejection asserts that Hemphill and Böttger et al. disclose all of the features of the claimed invention except for the specific features called out in claims 31, and 35-41.<sup>1</sup>

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<sup>1</sup> In addition to the 35 U.S.C. §103(a) rejections, the Final Rejection objected to the Specification for the first time because of the reference to claim numbers. Appellant will make the appropriate corrections with the next response.

## **ARGUMENT**

### **I. REJECTION OF CLAIMS 16-45 UNDER 35 U.S.C. §112, SECOND PARAGRAPH:**

#### **ARGUMENTS CONCERNING CLAIMS 16-45**

The Examiner's Answer has rejected claims 16-45 under 35 U.S.C. § 112, second paragraph for the first time. Appellant would like to note that the Examiner's Answer does not properly call out the claim limitation. The Examiner's Answer states that "wherein the *mattress* is substantially the same size of a mattress" is indefinite. The claim element reads "wherein the *material* is substantially the same size of a mattress."

The Examiner's Answer does not provide support for the statement "it is not proper for Applicant to compare the features of the claimed invention to elements that are not part of the claimed invention." In fact, this statement appears to contradict § 2173.05(b) of the MPEP which states that "the fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C § 112, second paragraph."<sup>2</sup> This section goes on to state, "acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification."<sup>3</sup> *Orthokinetics Inc. v. Safety Travel Chairs Inc.* handled this issue and stated that "a decision on whether a claim is invalid under § 112 [second paragraph], requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification."<sup>4</sup> The Examiner's Answer has not completed this analysis. In fact, if the Examiner's Answer had reviewed the specification it would have found that the specification clearly supports a material that is substantially the same size of a mattress. For example, Figures

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<sup>2</sup> MPEP § 2173.05(b).

<sup>3</sup> Id.

<sup>4</sup> *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

1 and 6 show the material used with a mattress. The specification also states “[s]ince in the field of hospitals, homes for the elderly and nursing homes the dimensions of mattresses 1 are largely uniform, it is usually possible to manage with an underlay mat 4 of a specific format.”<sup>5</sup> The Examiner’s Answer even acknowledges that mattresses come in a variety of standard sizes ranging from crib mattresses to king-sized mattresses.<sup>6</sup> Since mattresses are standardized in order to fit bed frames, the claim is not rendered indefinite by reference to “a mattress” in the claims.

The Examiner’s Answer states that it is not proper to compare the features of the claimed invention to elements that are not part of the claimed invention. Appellant would like to point out that “a mattress” is part of the preamble of the claim.

Appellant accordingly requests reversal of the rejection of claims 16-45 as indefinite under 35 U.S.C. § 112, second paragraph.

## **II. REMAINING REJECTIONS**

Appellant maintains all of the arguments presented in the Appeal Brief for the remaining rejections.

The Examiner’s Answer includes several contentions that require clarification.

The Examiner’s Answer discusses the material being substantially the size of the mattress. The Examiner’s Answer states that the claims do not positively recite a mattress. This is incorrect as “a mattress” appears in the preamble. The Examiner’s Answer states that failure to specify dimensions of the material leaves the claimed invention subject to interpretation. Appellant disagrees for the reasons discussed above and primarily that mattress come in several standard sizes. The Examiner’s Answer states that because Figure 3 of Hemphill is supporting a

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<sup>5</sup> Specification as filed at page 4 lines 24-26.

<sup>6</sup> See Examiner’s Answer paragraph 10 page 10.

person that “supporting a person” is the same as “substantially the size of a mattress.” The Examiner’s Answer elaborates on this by discussing what is the “useful portion” or the “desirability to support the entire body of a person on an evacuation restraint device.” Appellant has not given “supporting a person” as the benchmark for “substantially” and therefore does not expect that limitation to be read into the claims. Further, the Examiner’s Answer has even described *substantially* as another word for *approximately*. Appellant does not see how “supporting a person” with perhaps half or one-third of the mattress being supported is the same as *approximately* the size of the mattress. Finally, the Examiner’s Answer states that

a purported difference in size between the material of Appellant’s invention and that of the prior art is regarded as neither novel or nonobvious. The size of the material of Appellant’s invention does not result in the solution of a new problem, does not significantly affect the operation of the rescue underlay and does not require new methods or materials for manufacture. The limitation, is therefore, met by the material of the prior art combination.

Appellants request that elements of the claims be considered as a whole. See MPEP § 2141.02(I) and (II).

The Examiner’s Answer states that “prior to heating the spacing” contends that while the spring force of the spacing fabric is released by the application of heat, it is not necessary to apply heat during rescue operations and that heat may be applied for example during assembly and manufacturing. This analysis of Böttger et al. is not part of the reference at all. Böttger et al. teaches the use of heat to expand for reinforcing structural components like metallic plates or containers such as tanks. A fair reading of Hemphill and Böttger et al. is the evacuation restraint of Hemphill having a mattress and an underlay where the underlay has the spacing fabric of Böttger et al. where the spacing fabric starts out as one layer and expands upon heating to provide two layers spaced apart. Even under a post-KSR analysis there still needs to be some

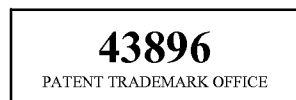
articulated reasoning for the combination and not just a conclusory statement. Further, the combination cannot render the prior art unsatisfactory for its intended purpose. The combination of Hemphill and Böttger et al. would render the device unsatisfactory for the reasons already discussed in this reply brief and the appeal brief.

Regarding the remaining statements of the Examiner's Answer, the Examiner appears to be reading elements into the references. Appellants request that the references be considered for what they say without additional elements being added.

### **CONCLUSION**

Appellant disagrees with the new §112 rejection. And, no proper basis has been given for a person having ordinary skill in the art of making beds to combine Hemphill and Böttger et al. or to take the further step of adding Failor or the common knowledge in the art. Accordingly, the references should never have been combined in the manner set out in the Final Rejection.

Appellant accordingly requests that the 35 U.S.C. § 112 and §103(a) rejections be reversed.



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Dated: February 11, 2008

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